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09/702,004	10/30/2000	Vladimir Victorovich Schipunov	291508006US1	7812

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EXAMINER	
LASTRA, DANIEL	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/702,004	SCHIPUNOV ET AL.	
	Examiner	Art Unit	
	DANIEL LASTRA	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-51 have been examined. Application 09/702,004 (Targeting electronic advertising placement in accordance with an analysis of user inclination and affinity) has a filing date 10/30/2000 and Claims Priority from Provisional Application 60/167,060 ((11/22/1999).

Response to Amendment

2. In response to Non Final Office Action dated 11/03/2004, the Applicant filed an Appeal Brief. In view of the Appeal Brief filed on 09/09/04, PROSECUTION IS HEREBY REOPENED.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 101

3. Claims 22-24 and 34 are rejected under 35 U.S.C. 101 as non-functional descriptive material. The data structure described in claims 22-24 and 34 is simply a data file – no functional change occurs when an application program uses the structural data. The data is not performing the step of selecting a candidate advertising outlet on which to

place advertising message for the selected advertiser. The "data structure are usable to select" is the intended use of said data but said data is not performing the step of said selecting.

Claims 2, 7-14, 16, 19-21, 28, 29 and 35-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of: (1) whether the invention is within the technological arts; and (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the instant claims fail to recite the use of any type of technology within the recited steps of measuring a desirability of placing with an advertisement publisher one or more advertising messages.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

Although the claimed invention produces a useful, concrete and tangible result, since the claimed invention as a whole is not within the technological arts, as explained above, claims 2, 7-14, 16, 19-21, 28, 29 and 35-37 are deemed to be directed to non statutory subject matter.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 42, 43 and 48-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter (i.e. "identifying a plurality of users that have viewed a television channel of a selected advertiser") which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 2-6, 13, 14, 16-22, 28-31, 33, 34, 36, 38-41 and 44-47 are rejected under 35 U.S.C. 102(a) as being anticipated by Wexler (US 5,960,409).

As per claims 2, 22, 28, 34 and 36, Wexler teaches:

A method in a computing system for assessing, for a selected advertiser and each of a plurality of candidate advertising outlets, a measure of the desirability of placing with the candidate advertising outlet one or more advertising messages for the selected advertiser, comprising, for each of the plurality of candidate advertising outlets:

identifying a plurality of users that have visited the candidate advertising outlet (see Wexler column 6, lines 1-10);

counting the number of identified users that have also visited the selected advertiser; and generating for the candidate advertising outlet a metric (i.e. column 6, lines 1-5 "percentage of clicks that results from the banner being displayed on a particular banner publisher's Web page if the total number of impressions is known") that compares the number of identified users to the number of counted users and constitutes a measure of the desirability of placing with the candidate advertising outlet one or more advertising messages for the selected advertiser (see Wexler column 2, lines 20-62; column 5, lines 24-30; column 6, lines 1-10).

As per claim 3, Wexler teaches:

The method of claim 2, wherein the candidate advertising outlets are web publishers (see Wexler column 5, lines 24-50).

As per claim 4, Wexler teaches:

The method of claim 2 wherein the candidate advertising outlets are Internet publishers (see Wexler column 5, lines 24-50).

As per claim 5, Wexler teaches:

The method of claim 2 wherein the candidate advertising outlets are electronic publishers (see Wexler column 5, lines 24-50).

As per claim 6, Wexler teaches:

The method of claim 2 wherein the metric is generated by dividing the number of counted users by the number of identified users (see column Wexler 2, lines 20-62; column 5, lines 24-30; column 6, lines 1-10' "percentage of clicks that results from the banner being displayed on a particular banner publisher's Web page if the total number of impression is known").

As per claim 13, Wexler teaches:

The method of claim 2, further comprising displaying the generated metric for each candidate advertising outlet (see column 6, lines 1-10).

As per claim 14, Wexler teaches:

The method of claim 2, further comprising:

analyzing the generated metrics; and selecting a candidate advertising outlet on which to place one or more advertising messages for the selected advertiser based upon results of the analysis (see Wexler column 5, line 24 – column 6, line 10).

As per claim 16, Wexler teaches:

The method of claim 2, further comprising discerning whether a user has visited the candidate advertising outlets and whether the user has visited the selected

advertiser by analyzing information traffic flowing to or from the user (see Wexler column 2, lines 20-62; column 5, lines 24-30; column 6, lines 1-10).

As per claim 17, Wexler teaches:

The method of claim 16 wherein the analysis analyzes universal resource locators contained in the traffic (see Wexler column 5, lines 24-45).

As per claim 18, Wexler teaches:

The method of claim 16 wherein the analysis analyzes filenames contained in the traffic (see Wexler column 5, lines 45-60).

As per claim 19, Wexler teaches:

The method of claim 16 wherein the analysis analyzes content contained in the traffic (see Wexler column 5, lines 45-60).

As per claim 20, Wexler teaches:

The method of claim 16 wherein the analysis analyzes textual content contained in the traffic (see Wexler column 5, lines 25-60).

As per claim 21, Wexler teaches:

The method of claim 16 wherein the analysis analyzes visual content contained in the traffic (see column 5, lines 45-60).

As per claim 29, Wexler teaches:

The method of claim 28, further comprising:

for each of a plurality of advertising outlets on which advertising messages for the advertiser have already been placed, generating a success metric characterizing the

level of success attributable to placing an advertising message for the advertiser on the advertising outlet (see Wexler column 6, lines 1-10; "percentage"); and

using the generated success metrics to select one of the advertising outlets on which advertising messages for the advertiser have already been placed as the distinguished advertising outlet (see Wexler column 5, lines 24-50). It is inherent that advertiser use the report generated by Wexler to select an advertising outlet on which to place their advertisements.

As per claim 30, Wexler teaches:

The method of claim 29 wherein the success metrics are generated based upon a click-through rate for advertising messages placed on the advertising outlet (see Wexler column 6, lines 1-10).

As per claim 31, Wexler teaches:

The method of claim 29 wherein the success metrics are generated based upon a conversion rate for advertising messages placed on the advertising outlet (see Wexler column 5, lines 24-50).

As per claim 33, Wexler teaches:

The method of claim 29 wherein the success metrics are generated based upon a factor specified by the selected advertiser for advertising messages placed on the advertising outlet (see Wexler column 5, lines 24-50).

As per claim 35, Wexler teaches:

A method in a computing system for selecting advertising outlets on which to place advertising messages for an advertiser, comprising:

for each of a first plurality of advertising outlets, assessing the rate at which visitors to the advertiser also visit the advertising outlet (see Wexler column 6, lines 1-10);

selecting an advertising outlet among the first plurality having the highest rate (see column 5, lines 24-35). It is inherent that Wexler rank the effectiveness of each publishing site);

for each of a second plurality of advertising outlets, assessing the tendency of a high performing advertising outlet to drive its visitors to the advertising outlet among the second plurality of advertising outlets (see column 6, lines 1-10);

selecting an advertising outlet among the second plurality of advertising outlets to which the high-performing advertising outlet has the greatest tendency to drive its visitors (see column 6, lines 1-10). It is inherent that advertisers would select the highest performing advertising outlet by using the Wexler effectiveness report (see column 6, lines 7-10).

As per claims 38-41, Wexler teaches:

The method of claim 2, wherein the candidate advertising outlet has a website, and wherein identifying a plurality of users that have visited the candidate outlet comprises identifying a plurality of users that have visited the website of the candidate advertising outlet (see Wexler column 6, lines 1-10).

As per claim 44, Wexler teaches:

The method of claim 28 wherein the candidate advertising outlet has a web site, and wherein measuring the tendency of visitors to the distinguished advertising outlet to

visit the candidate advertising outlet comprises measuring the tendency of visitors to the distinguished advertising outlet to visit the website of the candidate advertising outlet (see Wexler column 6, lines 1-10).

As per claim 45, Wexler teaches:

The method of claim 28 wherein the distinguished advertising outlet has a web site, and wherein measuring the tendency of visitors to the distinguished advertising outlet to visit the candidate advertising outlet comprises measuring the tendency of visitors to the website of the distinguished advertising outlet to visit the candidate advertising outlet (see Wexler column 6, lines 1-10).

As per claim 46, Wexler teaches:

The method of claim 28 wherein the candidate advertising outlet has a web site comprised of pages, and wherein measuring the tendency of visitors to the distinguished advertising outlet to visit the candidate advertising outlet comprises measuring the tendency of visitors to the distinguished advertising outlet to visit a selected page of the website of the candidate advertising outlet (see Wexler column 6, lines 1-20).

As per claim 47, Wexler teaches:

The method of claim 28 wherein the distinguished advertising outlet has a web site comprised of pages, and wherein measuring the tendency of visitors to the distinguished advertising outlet to visit the candidate advertising outlet comprises measuring the tendency of visitors to the website of the distinguished advertising outlet

to visit a selected page of the candidate advertising outlet (see Wexler column 6, lines 1-10).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta et al (U.S. 6,487,538) in view of Wexler (U.S. 5,960,409).

As per claims 1 and 25, Gupta teaches:

A method in a computing system for assessing, for a selected electronic advertiser having a web site and each of a plurality of electronic publishers each also having a website, a measure of the desirability of placing with the electronic publisher one or more advertising messages for the selected electronic advertiser, comprising:

for each of a plurality of users, storing a user identifier on a computer system used by the user (see Gupta column 16, line 35 – column 17, line 12; column 6, lines 23-30);

when one of the plurality of users visits the electronic advertiser website, receiving and storing an indication of a first type indicating that the user visited the

electronic advertiser website, the indication containing the user identifier stored on the computer system used by the user (see Gupta column 9, lines 10-32);

when one of the plurality of users visits the website of one of the plurality of electronic publishers, receiving and storing an indication of a second type indicating that the user visited the electronic publisher website, the indication containing the user identifier stored on the computer system used by the user and an identifier of the electronic publisher (see Gupta column 9, lines 10-32; column 11, lines 30-35; column 10, lines 9-22);

selecting the user identifiers contained in stored indications of the first type (see Gupta column 16, line 35 – column 17, line 12);

determining the number of unique selected user identifiers (see Gupta column 16, line 35 – column 17, line 12);

Gupta fails to teach for each of the electronic publishers, determining the number of selected user identifiers that are contained in at least one indication of the second type that also contains an identifier of the electronic publisher to obtain a count for the electronic publisher; dividing the count for the electronic publisher by the number of unique selected user identifiers to obtain an inclination metric for the electronic publisher; analyzing the inclination metrics obtained for the electronic publishers; and selecting one or more of the electronic publishers on which to place an advertising message for the advertiser based upon the analysis. However, Wexler teaches that a third-party on-line accounting system that accumulates and tabulates statistical information including the number of clicks on the advertiser banner, the origin of a user

and data indicative of the effectiveness of the banner-publisher frequently-visited Web site as an advertising medium (see column Wexler 2, lines 20-62; column 5, lines 24-30; column 6, lines 1-10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Gupta would uniquely identify each user that access a website using a cookie stores in said user's computer (see Gupta column 16, line 49 – column 17, line 12) and would use said unique identification (i.e. cookie) to count the unique users that visits a publisher site and also visit an advertiser site to determine the effectiveness of each publishing sites, as taught by Wexler. Gupta maintains a log file, which contains all information regarding all transmission performed by the system and said log file indicates the advertisements that were actually displayed to a user (see Gupta column 16, lines 35-67). It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Gupta would use said log file to count the numbers of unique users that visited a publisher site and an advertiser site and would divide said numbers by each other to determine an inclination metric for said publisher.

As per claims 26 and 27, Gupta teaches:

The method of claim 25 but fails to teach wherein candidate electronic publishers for which an affinity greater than one is obtained are selected. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Gupta would track and store the online activities of a unique user and would use this store data to determine which Internet Publishers would do better than others in placing particular advertisements, as taught by Wexler. Gupta would use

this stored data for ranking the different Internet Publishers in their desirability of placing particular advertisements by giving each Internet Publisher an affinity number, such an affinity number greater than one or five.

Claims 7-12, 15, 23, 24, 32 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler (U.S. 5,960,409) in view of Gupta et al (U.S. 6,487,538).

As per claims 7, 23 and 37, Wexler teaches:

The method of claim 2 but fails to teach wherein the counting counts the number of identified users that (a) have also visited the selected advertiser and (b) have not viewed an advertising message for the selected advertiser, and wherein the metric is generated by dividing the number of counted users by the number of identified users. However, Gupta maintains a log file which contains all information regarding all transmission performed by the system and said log file would indicate that advertisements that were actually displayed to a user (see Gupta column 16, lines 35-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Gupta would count the numbers of unique users that visited a publisher site and an advertiser site and have not displayed an advertisement of a selected advertiser and would divide the obtained numbers by each other to determine an inclination metric or effectiveness for said publisher, as taught by Wexler. Gupta's log file would keep track of a user's browsing activities and said tracking would be used to determine the effectiveness of each of the publishing sites.

As per claims 8 and 24, Wexler teaches:

The method of claim 2 but fails to teach wherein the counting counts the number of identified users that have also visited the selected advertiser without first viewing an advertising message for the selected advertiser, and wherein the metric is generated by dividing the number of counted users by the number of identified users. However, Gupta maintains a log file which contains all information regarding all transmission performed by the system and said log would indicate that advertisements that were actually displayed to a user (see Gupta column 16, lines 35-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Gupta would count the numbers of unique users that visited a publisher site and an advertiser site without first viewing an advertisement of a selected advertiser and would divide the obtained numbers by each other to determine an inclination metric or effectiveness for said publisher, as taught by Wexler. Gupta's log file would keep track of a user's browsing activities and said tracking would be used to determine the effectiveness of each of the publishing sites.

As per claim 9, Wexler teaches:

The method of claim 2 but fails to teach wherein a related advertiser is related to the selected advertiser, and wherein the counting counts the number of identified users that (a) have also visited the selected advertiser, (b) have not viewed an advertising message for the selected advertiser, and (c) have not viewed an advertising message for the related advertiser, and wherein the metric is generated by dividing the number of counted users by the number of identified users. However, Gupta maintains a log file which contains all information regarding all transmission performed by the system and

said log would indicate that advertisements that were actually displayed to a user (see Gupta column 16, lines 35-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Gupta would count the numbers of unique users that visited a publisher site and an advertiser site and have not viewed an advertisement of a selected advertiser or a related advertiser and would divide the obtained numbers by each other to determine an inclination metric or effectiveness for said publisher, as taught by Wexler. Gupta's log file would keep track of a user's browsing activities and said tracking would be used to determine the effectiveness of each of the publishing sites.

As per claim 10, Wexler teaches:

The method of claim 2 but fails to teach wherein a related advertiser is related to the selected advertiser, and wherein the counting counts the number of identified users that have also visited the selected advertiser without first (a) viewing an advertising message for the selected advertiser or (b) viewing an advertising message for the related advertiser, and wherein the metric is generated by dividing the number of counted users by the number of identified users. However, Gupta maintains a log file which contains all information regarding all transmission performed by the system and said log would indicate that advertisements that were actually displayed to a user (see Gupta column 16, lines 35-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Gupta would count the numbers of unique users that visited a publisher site and an advertiser site without first viewing an advertisement of a selected advertiser or a related advertiser

and would divide the obtained numbers by each other to determine an inclination metric or effectiveness for said publisher, as taught by Wexler. Gupta's log file would keep track of a user's browsing activities and said tracking would be used to determine the effectiveness of each of the publishing sites.

As per claim 11, Wexler teaches:

The method of claim 2 but fails to teach wherein the counting counts the number of identified users that (a) have also visited the selected advertiser and (b) have viewed an advertising message for the selected advertiser, and wherein the metric is generated by dividing the number of counted users by the number of identified users. However, Gupta maintains a log file which contains all information regarding all transmission performed by the system and said log file would indicate that advertisements that were actually displayed to a user (see Gupta column 16, lines 35-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Gupta would count the numbers of unique users that visited a publisher site and an advertiser site and have viewed an advertisement of a selected advertiser and would divide the obtained numbers by each other to determine an inclination metric or effectiveness for said publisher, as taught by Wexler. Gupta's log file would keep track of a user's browsing activities and said tracking would be used to determine the effectiveness of each of the publishing sites.

As per claim 12, Wexler teaches:

The method of claim 2 but fails to teach wherein the counting increments the count for each identified user that (a) visited the selected advertiser and (b) has viewed

an advertising message for the selected advertiser and decrements the count for each identified user that (c) visited the selected advertiser and (d) has not viewed an advertising message for the selected advertiser, and wherein the metric is generated by dividing the count by the number of identified users. However, Gupta maintains a log file which contains all information regarding all transmission performed by the system and said log would indicate that advertisements that were actually displayed to a user (see Gupta column 16, lines 35-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Gupta would count the numbers of unique users that visited a publisher site and an advertiser site and have viewed an advertisement of a selected advertiser or decrement a count for said users that have not viewed an advertisement for the selected advertiser and would divide the obtained numbers by each other to determine an inclination metric or effectiveness for said publisher, as taught by Wexler. Gupta's log file would keep track of a user's browsing activities and said tracking would be used to determine the effectiveness of each of the publishing sites.

As per claim 15, Wexler teaches:

The method of claim 2, but fails to teach further comprising discerning users that have visited the candidate advertising outlets and those that have visited the selected advertiser by analyzing the contents of logs of one or more web servers that collectively receive a request when a user visits one of the candidate advertising outlets and when a user visits the selected advertiser. However, Gupta maintains a log file which contains all information regarding all transmission performed by the system and said log would

indicate that advertisements that were actually displayed to a user (see Gupta column 16, lines 35-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Gupta would count the numbers of unique users that visited a publisher site and an advertiser site and would divide the obtained numbers by each other to determine an inclination metric or effectiveness for said publisher, as taught by Wexler. Gupta's log file would keep track of a user's browsing activities and said tracking would be used to determine the effectiveness of each of the publishing sites.

As per claim 32, Wexler teaches:

The method of claim 29 but fails to teach wherein the success metrics are generated based upon an average purchase amount for advertising messages placed on the advertising outlet. However, Gupta teaches a system where advertiser pays a publisher based on completed transaction obtained from a banner placed on said publisher (see Gupta column 4, lines 26-36; column 9, lines 10-33). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Wexler would use the complete transactions for advertising messages placed in a publisher site to determine the effectiveness of advertising in said publisher site, as taught by Gupta. This feature would allow to determine if advertisements placed in a publisher site produce a profit to an advertiser.

Claims 42, 43 and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler (U.S. 5,960,409) in view of Ozer et al (U.S. 6,708,335).

As per claims 42, 43 and 48-51, Wexler teaches:

The method of claim 2 but fails to teach wherein the candidate advertising outlet has a television channel, and wherein identifying a plurality of users that have visited the candidate advertising outlet comprises identifying a plurality of users that have viewed the television channel of the candidate advertising outlet. However, Ozer teaches a system that tracks users viewing behavior of advertisements displayed in television programs (see column 2, lines 46-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Wexler would track the advertisements viewed by users in televisions programs sponsored by advertisers, as taught by Ozer. Wexler would track the users viewing behavior and would use this information to determine which publisher would do better than others in placing particular advertisements.

Response to Arguments

5. Applicant's arguments filed 06/29/2005 have been fully considered but they are not persuasive. The Applicant argues that the Examiner fails to teach that claims 22-24 and 34 are directed to Non functional descriptive material. The Examiner answers that claims 22-24 and 34 recite the limitation that the contents stored in memory are "usable to select" and said limitation (i.e. "usable to select") is the intended use of said data but said data is not performing the step of said selecting.

The Applicant argues that Gupta's click-through data is an indication of a "referral" from one web site to another and Appellant's technique utilizes inclination data which can be thought of as "co-visits", in that it is measure of the extent to which users that visit the advertiser's website also visit a candidate publisher's website, irrespective

of whether on the these two websites is visited as the result of following a link to it on page of the other web site. The Examiner answers that the Applicant is arguing about features that are not stated in the claims. Nowhere, in the claims is stated that said inclination data cannot be obtained from click-through data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The Examiner's Right fax number is 571-273-6720.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
September 7, 2005

RAQUEL ALVAREZ
PRIMARY EXAMINER